Application Number 10/538634
Response to the Office Action dated May 22, 2008

REMARKS

Favorable reconsideration of this application is requested in view of the following remarks.

Claims 1 and 12 have been amended to clarify that the surface of the inorganic micropowder is treated with polysiloxane and fatty acid or its derivative and include limitations of claim 2 and 13, respectively, and further limitations of the fatty acid and the derivative as supported by the specification at page 15, lines 7-13, 15-17, and 24-28, page 15, line 29 – page 16, line 4, and page 16, lines 14-21; accordingly, claims 2 and 13 have been canceled without prejudice and claims 7 and 18 have been amended to coincide with the terms and limitations used in claims 1 and 12, respectively; and claims 5, 11, 16, and 22 have been amended editorially.

Claims 1-5 have been rejected under 35 U.S.C. 102(e) as being anticipated by Yoshino et al. (U.S. Patent Application Publication No. 2004/0058258). Applicant respectfully traverses this rejection.

Claim 1 requires that the inorganic micropowder be treated with polysiloxane and one of fatty acids, fatty acid esters, aliphatic amides, and fatty acid metal salts. The 102(e) date of Yoshino is April 9, 2003. Japanese priority application No. JP2002-358641 filed on December 10, 2002 discloses the additives that include inorganic micropowder treated with polysiloxane and one of fatty acids esters, aliphatic amides, and fatty acid metal salts (see para. [0036] at page 13 of the translation submitted previously). In addition, all fatty acids and their metals used for fatty acid metal salts, fatty acid amides, and fatty acid esters (1)-(4) of claim 1 are listed in JP2002-358641 (see paragraphs [0042], [0043], [0044], and [0045] at page 15 of the translation). Accordingly, Yoshino is not prior art against claim 1, and this rejection should be withdrawn.

Claims 1-3 and 6 have been rejected under 35 U.S.C. 102(e) as being anticipated by Sugiura et al. (U.S. Patent Application Publication No. 2003/0152857). Applicant respectfully traverses this rejection.

Claim 1 requires that the inorganic micropowder be treated with polysiloxane and one of fatty acids, fatty acid esters, aliphatic amides, and fatty acid metal salts. Sugiura discloses a toner containing additives that include inorganic fine particles such as silica fine particles and/or metal salts of aliphatic additives such as zinc stearate (see paras. [0203] and [0204]). In Sugiura, the particles of zinc stearate are simply added to and mixed with silica in dimethyl silicone oil (see example 9-B at para. [0534]). Accordingly, the fine particles of silica and zinc stearate would be in a form of separate particles in the toner and the adhesion between the inorganic micropowder silica and zinc stearate and between silica and dimethyl silicone is not strong. For example, example B-9 of the reference shows more transfer dust, i.e., back transfer, than example B-1 that does not include zinc stearate (see table 4 at pages 38-39). In contrast, in claim 1, the surface of inorganic micropowder is treated with polysiloxane and one of fatty acids, fatty acid esters, aliphatic amides, and fatty acid metal salts (hereinafter collectively referred as to "Fatty acid"), and from this treatment, polysiloxane and Fatty acid coat the surface of the inorganic micropowder and adhere to the surface (see page 16, lines 14-21). All examples of claim 1 shows no back transfer (see table 13 at page 100 of the specification). Therefore, the adhesion between the inorganic micropowder and polysiloxane and the inorganic micropowder and Fatty acid in claim 1 would be different from and better than that adhesion of the reference. Accordingly, claim 1 is distinguished from Sugiura, and this rejection should be withdrawn.

Claims 12-14, 17, 23, and 24 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiura et al. (U.S. Patent Application Publication No. 2003/0152857) in view of Kobayashi et al. (U.S. Patent Application Publication No. 2003/0091923). Applicant respectfully traverses this rejection.

Claim 12 includes the features of claim 13, and claim 13 has been canceled. Claim 12 is distinguished from Sugiura for at least the same reasons as discussed for

claim 1 above. Kobayashi is directed to aspects of a carrier, not a toner, in a two-component developer and does not remedy the deficiencies of Sugiura about the toner of claim 12. Accordingly, claim 12 is distinguished from Sugiura in view of Kobayashi, and this rejection should be withdrawn. Applicant does not concede the correctness of the rejection.

Claims 4 and 5 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Sugiura et al. (U.S. Patent Application Publication No. 2003/0152857) in view of "Technical Information TI 1222, Special Hydrophobic AEROSIL® (SHA) for Toners," Nippon Aerosil, p. 5. Applicant respectfully traverses this rejection.
Claim 1 and accordingly, claims 4 and 5 are distinguished from Sugiura for at least the same reasons as discussed for claim 1 above. TI 1222 does not remedy such deficiencies of Sugiura. Accordingly, these claims are distinguished from Sugiura in view of TI 1222, and this rejection should be withdrawn. Applicant does not concede the correctness of the rejection.

Claims 15 and 16 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Sugiura et al. (U.S. Patent Application Publication No. 2003/0152857) in view of Kobayashi et al. (U.S. Patent Application Publication No. 2003/0091923); in view of "Technical Information TI 1222, Special Hydrophobic AEROSIL® (SHA) for Toners," Nippon Aerosil, p. 5. Applicant respectfully traverses this rejection.

Claim 12 and accordingly, claims 15 and 16 are distinguished from Sugiura in view of Kobayashi for at least the same reasons as discussed for claim 12 above. TI 1222 does not remedy such deficiencies of Sugiura and Kobayashi. Accordingly, these claims are distinguished from Sugiura in view of Kobayashi and TI 1222, and this rejection should be withdrawn. Applicant does not concede the correctness of the rejection.

Claim 10 has been rejected under 35 U.S.C. 103 (a) as being unpatentable over Sugiura et al. (U.S. Patent Application Publication No. 2003/0152857) in view of Tyagi et al. (U.S. Patent No. 6,156,473). Applicant respectfully traverses this rejection.

Claim 1 and accordingly, claim 10 are distinguished from Sugiura for at least the same reasons as discussed for claim 1 above. Tyagi does not remedy such deficiencies of Sugiura. Accordingly, claim 10 is distinguished from Sugiura in view of Tyagi, and this rejection should be withdrawn. Applicant does not concede the correctness of the rejection.

Claim 21 has been rejected under 35 U.S.C. 103 (a) as being unpatentable over Sugiura et al. (U.S. Patent Application Publication No. 2003/0152857); in view of Kobayashi et al. (U.S. Patent Application Publication No. 2003/0091923) and further in view of Tyagi et al. (U.S. Patent No. 6,156,473). Applicant respectfully traverses this rejection.

Claim 12 and accordingly, claim 21 are distinguished from Sugiura in view of Kobayashi for at least the same reasons as discussed for claim 12 above. Tyagi does not remedy such deficiencies of Sugiura and Kobayashi. Accordingly, claim 21 is distinguished from Sugiura in view of Kobayashi and further in view of Tyagi, and this rejection should be withdrawn. Applicant does not concede the correctness of the rejection.

Claims 7-11 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Sugiura et al. (U.S. Patent Application Publication No. 2003/0152857) in view of Yuasa et al. (U.S. Patent Application Publication No. 2002/0086229). Applicant respectfully traverses this rejection.

Claim 1 and accordingly, claims 7-11 are distinguished from Sugiura for at least the same reasons as discussed for claim 1 above. Yuasa does not remedy such deficiencies of Sugiura. Accordingly, claims 7-11 are distinguished from Sugiura in view of Yuasa, and this rejection should be withdrawn. Applicant does not concede the correctness of the rejection.

Claims 18-22 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Sugiura et al. (U.S. Patent Application Publication No. 2003/0152857) in view of

Kobayashi et al. (U.S. Patent Application Publication No. 2003/0091923) and further in view of Yuasa et al. (U.S. Patent Application Publication No. 2002/0086229). Applicant respectfully traverses this rejection.

Claim 12 and accordingly, claims 18-22 are distinguished from Sugiura in view of Kobayashi for at least same reasons as discussed for claim 1 above. Yuasa does not remedy such deficiencies of Sugiura and Kobayashi. Accordingly, claims 18-22 are distinguished from Sugiura in view of Kobayashi and further in view of Yuasa, and this rejection should be withdrawn. Applicant does not concede the correctness of the rejection.

In view of the above, Applicants request reconsideration of the application in the form of a Notice of Allowance.

Respectfully submitted,

HAMRE, SCHUMANN, MUELLER & LARSON, P.C.
P.O. Box 2902
Minneapolis, MN 55402-0902
(612) 455-3800

Dated: July 22, 2008

By: _____
Douglas P. Mueller
Reg. No. 30,300

DPM/my/ad